| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/519,151 | 03/06/2000 | Manuel Zahariev | P3001D1 | 7821 |

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| EXAMINER |
|---|
| DONAGHUE, LARRY D |

| ART UNIT | PAPER NUMBER |
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| 2154 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

4

| | | Application No. | Applicant(s) |
|---|---|---|---|
| *Office Action Summary* | | 09/519,151 | ZAHARIEV, MANUEL |
| | | **Examiner** | **Art Unit** | |
| | | Larry D. Donaghue | 2154 | |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on _22 June 2007_.

2a)☒ This action is **FINAL**.　　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _1-13 and 15-29_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-13 and 15-29_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

1.      Claims 1-13 and 15-29 are presented for examination.

2.      The rejection is maintained and presented below.

3.      35 U.S.C. 103(a) as being unpatentable over Pepe et al. (5,742,905) in view of Mizikovsy

(5,559,860).

Note for claims 1-8 is interpreted to be software.

        Pepe et al. taught the invention substantially (claim 1) as claimed, a server (40) connected to a

network; and a Mail Alert code set resident and operable on the server, wherein the agent is adapted to

compare characteristics of e-mail messages received for the subscriber to specific message

characteristics provided by the subscriber and pre-stored on the server (col. 4, line 56- col. 5, line 9; col.

7, line 3-15), to alert the subscriber when a characteristic match is found, (col. 31, lines 30-65) and to

execute instructions received from the subscriber in response to the alert for forwarding of the message

received for which a match was found (col. 34, lines 59-65; col. 4, line 56-67 and fig 35-39) .

        Though, Pepe et al. may not expressly disclose the operation of the CallCommand  to e-mail,

Pepe et al. does disclose the operation, directed to voice mail, it would have been obvious to one of

ordinary skill in the art to combine the teaching directed to wireless voice to wireless E-mail as it is

expressly suggested by Pepe et al. "Wireless technologies make subscribers constantly available,

therefore it is important to give them the ability to accept or decline communication attempts at their

discretion." Combine with the teaching of wireless e-mail "Sending and receiving e-mail wireless

messages involves two types of message flows: sending messages from the PDA 30 to the PCI server

48 and from the PCI server 48 to the PDA 30."

        Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message

is identified by the sender, and that the end user determines the course of act to take based on the

identity of the sender. Mizikovsky taught including additional identifying data in an alert with information

message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been

obvious to modify  Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-

60.

        As to claim 2,  Pepe et al. taught  the subscriber is alerted on finding a characteristic match by

sending a page to a paging device carried by the subscriber (col. 5, lines 60-67).

Pepe et al. taught the invention substantially (claim 5) as claimed, an agent (40) adapted for receiving and forwarding e-mail; and a Mail Alert system adapted to compare characteristics of e-mail messages received for the subscriber to specific message characteristics provided by the subscriber and pre-stored on the server (col. 4, line 56- col. 5, line 9; col. 7, line 3-15), to alert the subscriber when a characteristic match is found (col. 31, lines 30-65), and to execute instructions received from the subscriber in response to the alert for forwarding of the message received for which a match was found (col. 34, lines 60-65; col. 4, line 56-67 and fig 35-39.

Though, Pepe et al. may not expressly disclose the operation of the CallCommand to e-mail, Pepe et al. does disclose the operation, directed to voice mail, it would have been obvious to one of ordinary skill in the art to combine the teaching directed to wireless voice to wireless E-mail as it is expressly suggested by Pepe et al. "Wireless technologies make subscribers constantly available, therefore it is important to give them the ability to accept or decline communication attempts at their discretion." Combine with the teaching of wireless e-mail "Sending and receiving e-mail wireless messages involves two types of message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message is identified by the sender, and that the end user determines the course of act to take based on the identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

As to claim 6, Pepe et al. taught the invention the subscriber is alerted on finding a characteristic match by sending a page to a paging device carried by the subscriber (col. 5, lines 60-67).

As to claim 9, Pepe et al. taught prerecording on a mail server characteristics for messages to be routed, the characteristics provided by a subscriber; receiving messages addressed to the subscriber at the mail server;

comparing characteristics of messages received to the prerecorded characteristics provided by the subscriber (col. 4, line 56- col. 5, line 9; col. 7, line 3-15); identifying and storing on the mail server messages received for the subscriber for which a match is found to the prerecorded characteristics (col.

4, line 56- col. 5, line 9; col. 7, line 3-15); alerting the subscriber to the receipt of one or more messages

for which a characteristic match is found (col. 4, line 56- col. 5, line 9; col. 7, line 3-15, col. 31, lines 30-

65); receiving instructions for forwarding the stored messages from the subscriber in response to the alert

Col. 31, lines 32-65 and col. 29, lines 42-64); and; forwarding the stored messages for which a match is

found to destinations provided by the subscriber in response to the alert (col. 19, line 30- col. 20, line 25)..

Though, Pepe et al. may not expressly disclose the operation of the CallCommand to e-mail, Pepe et al.
does disclose the operation, directed to voice mail, it would have been obvious to one of ordinary skill in
the art to combine the teaching directed to wireless voice to wireless E-mail as it is expressly suggested
by Pepe et al. "Wireless technologies make subscribers constantly available, therefore it is important to
give them the ability to accept or decline communication attempts at their discretion." Combine with the
teaching of wireless e-mail "Sending and receiving e-mail wireless messages involves two types of
message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to
the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message
is identified by the sender, and that the end user determines the course of act to take based on the
identity of the sender. Mizikovsky taught including additional identifying data in an alert with information
message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been
obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-
60.

As to claim 10, Pepe et al. taught wherein, in the alerting step, a page is sent to a pager carried

by the subscriber to alert the subscriber to the receipt of the one or more messages (col. 5, lines 60-67).

As to claim 13, Pepe et al. taught agent for processing e-mail messages, comprising: a stored list

of message characteristics provided by a subscriber; a receiver adapted for receiving e-mail messages

and ascertaining message characteristics of the received messages (col. 4, line 56- col. 5, line 9; col. 7,

line 3-15); a comparator adapted for comparing characteristics of received messages with stored

characteristics, and tagging those messages wherein the characteristics match (col. 4, line 56- col. 5, line

9; col. 7, line 3-15); an alert mechanism for alerting a subscriber to the receipt of messages having

characteristics matching the stored characteristics (col. 4, line 56- col. 5, line 9; col. 7, line 3-15),; and a

save facility adapted for storing matched messages against future distribution instructions, the future

distribution instructions received from the subscriber in response to the alert (col. 19, line 30- col. 20, line 25).

Though, Pepe et al. may not expressly disclose the operation of the CallCommand to e-mail, Pepe et al. does disclose the operation, directed to voice mail, it would have been obvious to one of ordinary skill in the art to combine the teaching directed to wireless voice to wireless E-mail as it is expressly suggested by Pepe et al. "Wireless technologies make subscribers constantly available, therefore it is important to give them the ability to accept or decline communication attempts at their discretion." Combine with the teaching of wireless e-mail "Sending and receiving e-mail wireless messages involves two types of message flows: sending messages from the PDA 30 to the PCI server 48 and from the PCI server 48 to the PDA 30."

Pepe et al. did not expressly teach the use of message ID, Pepe et al. did teach that the message is identified by the sender, and that the end user determines the course of act to take based on the identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

As to claim 15, Pepe et al. taught the alert mechanism comprises a page transmitter adapted for transmitting a page signal to a pager carried by the subscriber (col. 5, lines 60-67).

As to claim 16, Pepe et al. taught a forwarding facility for retrieving and forwarding stored messages to destinations provided by the subscriber (col. 19, line 30- col. 20, line 25).

Claims 4, 8,11 and 17 are rejected under 35 U.S.C. 103(a) as applied to claims 1, 2, and 5-6 as being unpatentable over Pepe et al. (5,742,905).

Pepe et al. did not expressly disclose the use of the automated telephone menu for responding to the alert. Pepe et al. did disclose the use of a telephone menu (col. 11, lines 14-32) and Pepe et al. discloses the use of cross media notification and performing the redirection in real time (col. 20, line 42 - col. 21, line 53). Pepe et al. taught that the system is for operating with mobile equipment such as PDA, pager and cellular phone (col. 5, lines 56-67). It would have been obvious to one of ordinary skill in the art at the time of the invention in view of the cited teachings that an automated telephone menu for

identity of the sender. Mizikovsky taught including additional identifying data in an alert with information message Col. 4, lines 55-64, col. 1, line 57 – col. 2, line 5, col. 10, line 40-54), it would have been obvious to modify Pepe et al. with Mizikovsky as it is expressly suggested by Mizikovsky col. 4, lines 57-60.

As to claim 20, Pepe et al. taught the message is an email message (col. 20, lines 13-53) .

As to claim 21, Pepe et al. taught the alert is a notification message that identifies the received message and criteria matching the message (col. 20, lines 13-53).

As to claim 22, Pepe et al. taught the comparing step comprises filtering the message to determine if parts of the message meet the criteria (col. 4, line 56- col. 5, line 9; col. 7, line 3-15).

As to claim 23, Pepe et al. taught the criteria are selected from the group consisting of message sender information; message subject line information; message body information; and message attachment information.

The claim is in the alternative, see (col. 29, line 42- col. 30, line 13, figures 38 and 39).

As to claim 24, Pepe et al. taught wherein the alert comprises at least a portion of the message (col. 20, lines 42-57).

As to claim 25, Pepe et al. taught the alert is a message sent to a pager (col. 23, line 63 – col. , line 13).

As to claim 26, Pepe et al. taught wherein the alert is a message sent to a phone (32,26).

As to claim 27, Pepe et al. taught the instructions comprise a command to forward the message to a new destination (col. 29, line 47- col. 30, line 13).

As to claim 28, Pepe et al. taught the new destination is selected from the group consisting of an e-mail address; a fax number; a telephone number; a hand-held computer; a notebook computer; a server computer; and an Internet Service Provider (ISP) (col. 29, line 47-col. 30, line 13, figure 3, 22, 48, 32, 24, 34).

As to claim 29, Pepe et al. taught wherein the reply is received via an entity selected from the group consisting of an operator; a voice-response system; a telephone call; an auto attendant; and a two-way pager.

The claim is in the alternative Pepe et al. taught at least the use of a phone (32,26).

4.      Applicant's arguments filed 06/22/2007 have been fully considered but they are not persuasive.

5.      Applicant appears to argue in substance that the cited references fail to teach a message ID.

6.      In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.  See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7.      Applicant appears to be arguing that each message has a unique ID, examiner is unable to find this limitation in the claim.

8.      **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.  In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.  In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
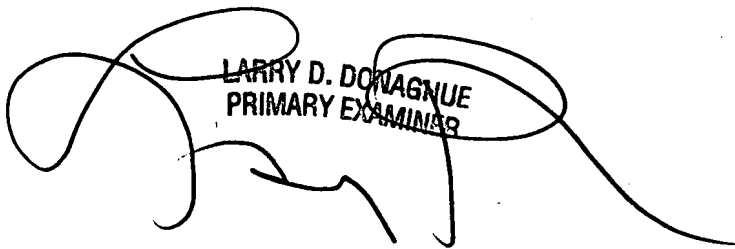
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962.  The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915.  The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LARRY D. DONAGHUE
PRIMARY EXAMINER